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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,513	10/31/2003	John K. Pratt	6998US02	7849
23492	7590	03/05/2010		
PAUL D. YASGER ABBOTT LABORATORIES 100 ABBOTT PARK ROAD DEPT. 377/AP6A ABBOTT PARK, IL 60064-6008			EXAMINER FRYOR, ALTON NATHANIEL	
			ART UNIT	PAPER NUMBER
			1616	
			NOTIFICATION DATE	DELIVERY MODE
			03/05/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents\_Abbott\_Park@abbott.com

### Office Action Summary

**Application No.**

10/699,513

**Applicant(s)**

PRATT ET AL.

**Examiner**

ALTON N. PRYOR

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-28, 30-35, 52-57, 62-71, 74 and 90-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 52-57, 62-71, 74, 90-92, 96, 97 is/are allowed.
- 6) ☒ Claim(s) 25-27, 30-35 and 93-95 is/are rejected.
- 7) ☒ Claim(s) 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Applicant's arguments filed 12/29/09 have been fully considered but they are not persuasive. Previous rejections not addressed below are withdrawn. See discussion below.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-27,30-35,93-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darcy et al (WO 03/059356; 7/23/03). Darcy et al. suggest the compounds of formula I where A is benzene or pyridine; Y = hydroxy; W = H, alkyl, alkenyl or alkynyl; B = thiophene, RB2 = -N(R11)SO2R13; R13 = alkyl. Darcy et al. teach that the compounds can be formulated into a composition further comprising another antiviral agent which would include the antivirals recited in the instant claims. Darcy et al. teach a method of administering the composition to a subject for treating herpes. See abstract, pages 1-8 and 33. Darcy et al. do not exemplify the instant compounds and their use in a method for treating hepatitis C. However, it would have been obvious to make the instant compounds and use the compounds in a method to treat hepatitis C. One would have been motivated to do this since Darcy et al. suggest the instant invention.

*Response to Applicants' argument*

The focus of Applicants argument center around the fact that the instant R5 group can be  $-N(Rf)SO_2Ra$ . The Examiner argues that Darcy et al. teach a R2B substituent being  $-N(R11)SO_2R13$ . Note, the substituents  $-N(Rf)SO_2Ra$  and  $-N(R11)SO_2R13$  can be the same. However, in Darcy et al the substituent  $[-N(R11)SO_2R13]$  differs in its positioning on the ring from the positioning of substituent  $[-N(Rf)SO_2Ra]$  on the ring of the instant structures making the structures positional isomers. Hence, these particular structures in Darcy et al. structures are positional isomers of the structures recited in the instant claims. In the absence of unexpected results for instant structures over Darcy et al. structures, Darcy et al. make instant structure obvious since positional isomers are known to exhibit similar chemical and physical properties.

The Applicants argue that the genus on pages 3-8 of Darcy et al. is board. The Applicants argue that Darcy et al. R1B and R3B definitions do not fit the definition of R5 in instant claim 25. The Examiner argues that Darcy et al. teach that R2B can be  $-N(R11)SO_2R13$  which is equivalent to  $-N(Rf)SO_2Ra$  for instant R5. R1B and R3B in Darcy et al. are in positions 1 and 3 on the ring, whereas instant R5 is in position 2 on the ring. Hence, Darcy et al. structures suggest positional isomers of structures in instant claims. In the absence of unexpected results for instant structure over Darcy et al. structures, Darcy et al. make instant structures obvious since positional isomers are known to exhibit similar chemical and physical properties.

Applicants specifically argue that not one of the forty seven species in Darcy et al. have A as a pyridyl ring as in claims 30 and 33. The Examiner argues that Darcy et al. suggests that the A ring can be pyridyl (pages 3-8). Note, the reference does not have to exemplify the instant structure in order to make the structure obvious.

Applicants argue that in claim 25 R5 can be  $-N(R_f)SO_2Ra$ . Applicants argue that only three of the examples in Darcy et al have A as phenyl and B as thienyl. However, none of these examples in Darcy et al. have the equivalent R5 as recited in claim 25. Note, Darcy et al. generically teach that A can be phenyl and B can be thienyl and R2B can be  $-N(R_{11})SO_2R_{13}$ . Based on this teaching it is obvious that Darcy et al. suggests the instant compound. Note, the reference does not have to exemplify the instant structure in order to make the structure obvious.

***Claim Objection/Allowable Subject Matter***

Claim 28 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 52-57,62-71,74,90-92,96 and 97 are allowable subject matter. An invention comprising the compounds embraced by claims 28,52-57,62-71,74,91,92,96 and 97 are not taught or suggested in the art.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALTON N. PRYOR whose telephone number is (571)272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Alton N. Pryor/  
Primary Examiner, Art Unit 1616